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A client-server logical view 60 is provided in Figure 5, which shows the steps of access and data flow in the primary use case of the present invention. Contact is established by the content provider when they enter the Universal Resource Locator (URL) for the present system into their web browser 62 (Internet Explorer and Navigator are among the possible browsers). Access to the system is provided by an HTTP server 64 which answers the browser's HTML page request. The content provider will establish a working session with the system by logging-in. Supporting the session and dynamic data exchange is a Hypertext Preprocessor 66. In a preferred embodiment, the system uses the APACHE HTTP Server (sold by Apache Software Foundation of Forest Hill, Maryland), which is integrally compiled with the PHP hypertext processor (developed by PHP Development Team of which is centralized at [www.php.net] the PHP Development Team Internet web site).

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The content provider connects their desktop computer 62 via a browser to the HTTP Server 64 by entering the system's URL (e.g. <http://www.cineeast.com>)an Internet web site address) into their browser. The content provider enters a user name and password as part of the login process. The PHP script instructions call a login service in transactional services 68, which, in turn, queries the database 70 for a match. If a match is found then a session is created under the content provider's account and the user is presented with a main page offering a series of options for the creation and management of content managed as jobs. The content provider creates a job that is stored in the database 70 by way of similar PHP script instruction(s) and transactional service(s). Among the information stored as part of the job is a requested schedule of showings for the content, the locations of the showings

Please rewrite claims 1, 3, 5, 8, 9, 11, 14, and 15 as follows:

--1. (Amended) A system for communicating with, and providing data representative of advertisement information to, movie projection equipment in theatres, said system comprising:
a computer storage unit for receiving and storing data representative of advertisement information;

a plurality of digital projector assemblies coupled to said computer storage unit for receiving data from said computer storage unit;

~~[a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies;]~~ and

a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly. ~~[said movie identification input unit]~~

3. (Amended) A system as claimed in claim 1, wherein said movie show schedule information regarding a movie includes ~~[identification input unit further receives]~~ information regarding an assigned time that the movie is to be shown in the theatre environment associated with said first of said plurality of digital projector assemblies.

5. (Amended) A system as claimed in claim 1, wherein said movie show schedule information regarding a movie includes ~~[identification input unit further receives]~~ information

regarding an assigned location that the movie is to be shown in the theatre environment associated with said first of said plurality of digital projector assemblies.

8. (Amended) A system as claimed in claim 1, wherein said system further includes assembling means for assembling a plurality of frames into a composite frame for output by said first digital projector assembly, wherein at least one of said plurality of frames includes data representative of advertisement information responsive to said movie show schedule information [identification input unit].

9. (Amended) A system for communicating with, and displaying data representative of advertisement information to, movie projection equipment in theatres, said system comprising:

 a computer storage unit for receiving and storing data representative of advertisement information;

 a processing unit coupled to said computer storage unit; and

 a plurality of digital projector assemblies coupled to said processing unit, said plurality of digital projector assemblies including a first projector assembly for use in a first theatre and a second projector assembly for use in a second theatre, and [; and

 a movie identification input unit for receiving first theatre scheduling information ~~regarding a movie that is to be shown in the first theatre, said movie identification input unit being coupled to said processing unit, and~~] said processing unit being adapted to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to [said] first theatre scheduling information regarding a movie that is to be shown in the first theatre.

11. (Amended) A system as claimed in claim 10, wherein said system further includes a network in communication with said plurality of digital projectors[,] and said processing unit, [and said movie identification input unit].

14. (Amended) A system as claimed in claim 9, wherein said [movie identification input unit also receives said second theatre scheduling information regarding a movie that is to be shown in the second theatre, and said] processing unit is adapted to provide a second portion of the data representative of advertisement information to the second digital projector assembly responsive to [said] second theatre scheduling information regarding a movie that is to be shown in the second theatre.

15. (Amended) A method of providing data representative of advertisement information to movie projection equipment in theatres, said [system] method comprising the steps of:

initializing a computer storage unit for receiving and storing data representative of advertisement information;

receiving data from the computer storage unit at a plurality of digital projector assemblies;

[generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies;] and selecting certain stored data from the computer storage unit for transmission to [the] a first digital projector assembly of said plurality of digital projector assemblies responsive to [the] movie identification information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly.--

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1. A system for communicating with, and providing data representative of advertisement information to, movie projection equipment in theatres, said system comprising:

a computer storage unit for receiving and storing data representative of advertisement information;

a plurality of digital projector assemblies coupled to said computer storage unit for receiving data from said computer storage unit;

~~[a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies;]~~ and

a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly. [said movie identification input unit]

2. A system as claimed in claim 1, wherein said first of said plurality of digital projector assemblies includes a computer processing unit in communication with a digital projector.

3. A system as claimed in claim 1, wherein said movie show schedule information regarding a movie includes [identification input unit further receives]

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information regarding an assigned time that the movie is to be shown in the theatre environment associated with said first of said plurality of digital projector assemblies.

4. A system as claimed in claim 3, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned time.

5. A system as claimed in claim 1, wherein said movie show schedule information regarding a movie includes [identification input unit further receives] information regarding an assigned location that the movie is to be shown in the theatre environment associated with said first of said plurality of digital projector assemblies.

6. A system as claimed in claim 5, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned location.

7. A system as claimed in claim 1, wherein said system further includes a network coupled to said computer storage unit and to said plurality of digital projector assemblies.

8. A system as claimed in claim 1, wherein said system further includes assembling means for assembling a plurality of frames into a composite frame for output

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by said first digital projector assembly, wherein at least one of said plurality of frames includes data representative of advertisement information responsive to said movie show schedule information [identification input unit].

9. A system for communicating with, and displaying data representative of advertisement information to, movie projection equipment in theatres, said system comprising:

a computer storage unit for receiving and storing data representative of advertisement information;

a processing unit coupled to said computer storage unit; and
a plurality of digital projector assemblies coupled to said processing unit, said plurality of digital projector assemblies including a first projector assembly for use in a first theatre and a second projector assembly for use in a second theatre, and [; and

~~a movie identification input unit for receiving first theatre scheduling information regarding a movie that is to be shown in the first theatre, said movie identification input unit being coupled to said processing unit, and]~~ said processing unit being adapted to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to [said] first theatre scheduling information regarding a movie that is to be shown in the first theatre.

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10. A system as claimed in claim 9, wherein said first theatre scheduling information includes information regarding the time, date and location that a particular movie is to be shown.

11. A system as claimed in claim 10, wherein said system further includes a network in communication with said plurality of digital projectors[, and said processing unit, [and said movie identification input unit]].

12. A system as claimed in claim 9, wherein said scheduling information includes information regarding whether a particular showing of a particular movie is the first showing of the movie in that theatre.

13. A system as claimed in claim 9, wherein said scheduling information includes information regarding whether a particular showing of a particular movie is within the first week of the first showing of the movie in that theatre.

14. A system as claimed in claim 9, wherein said [movie identification input unit also receives said second theatre scheduling information regarding a movie that is to be shown in the second theatre, and said] processing unit is adapted to provide a second portion of the data representative of advertisement information to the second digital projector assembly responsive to [said] second theatre scheduling information regarding a movie that is to be shown in the second theatre.

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15. A method of providing data representative of advertisement information to movie projection equipment in theatres, said [system] method comprising the steps of:

initializing a computer storage unit for receiving and storing data representative of advertisement information;

receiving data from the computer storage unit at a plurality of digital projector assemblies;

~~[generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies;]~~ and

selecting certain stored data from the computer storage unit for transmission to ~~[the]~~ a first digital projector assembly of said plurality of digital projector assemblies responsive to ~~[the]~~ movie identification information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly.

16. The method as claimed in claim 15, wherein said method further includes the step of assembling a plurality of frames into a composite frame for output by the first digital projector, wherein at least one of the plurality of frames includes data representative of advertisement information responsive to the movie identification information.

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17. A system for providing advertisement information to an audience, said system comprising:

storage means for receiving and storing advertisement information regarding a plurality of advertisements;

common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;

selection means for selecting a subset of the advertisement information responsive to the common interest information; and

display means for permitting the selected subset of the advertisement information to be displayed to the first audience.

18. A system as claimed in claim 17, wherein said system further includes a movie attendance feedback unit for receiving data representative of information regarding the number of people comprising the first audience.

19. A system as claimed in claim 17, wherein said system further includes an exposure log generation unit for recording data representative of the display of the selected subset of the advertisement information to the first audience.

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20. A system as claimed in claim 17, wherein said system further includes an exposure log feedback unit for receiving a recording of the display of the selected subset of the advertisement information to the first audience.

21. A system as claimed in claim 17, wherein said system further includes an exposure reporting unit for recording data representative of information relating to the number of people that comprise the first audience, and the display of the selected subset of the advertisement information to the first audience.

22. A system as claimed in claim 17, wherein said common interest information includes information regarding a movie.

23. A system as claimed in claim 17, wherein said common interest information further includes information regarding the time of day that a movie is scheduled to be shown.

24. A system as claimed in claim 18, wherein said common interest information further includes information regarding whether the time of day that a movie is scheduled to be shown is the first showing of the movie in that theatre.

25. A method of providing advertisement information to an audience, said method comprising the steps of:

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providing a storage medium for storing advertisement information regarding a plurality of advertisements;

identifying a common interest characteristic that each of the members of a first audience has in common;

[generating] receiving common interest data representative of said common interest characteristic; and

selecting a subset of the advertisement information responsive to the common interest data.

26. A method as claimed in claim 25, wherein said method further includes the step of displaying the selected subset of the advertisement information to the first audience.

REMARKS

Claim of Priority under 35 U.S.C. § 119(e)(1)

Applicant's claim for domestic priority is denied in the office action because the provisional application allegedly "is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention." See the office action, p.2.

Applicant maintains the claim for domestic priority in the above referenced utility application to U.S. Provisional Patent Application Ser. No. 60/148,807 filed August 13, 1999. Applicant's provisional application was filed pursuant to 35 U.S.C. §111(b) which states, in part, that a provisional application shall include a specification conforming to the requirements of 35 U.S.C. §112, ¶1 and at least one drawing filed under §113. The Applicant's provisional application includes 25 pages of text and drawings. The drawings in the provisional application include fifteen figures within the text of the specification that correspond to Figures 1 - 15 of the present utility application. The text of the utility application also corresponds to the text of the provisional application.

The non-provisional utility application shall be afforded the priority date of the provisional application if the two applications share at least one common inventor and the specification of the provisional application contains a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. 35 U.S.C. §112, ¶1 and §119(e)(1). The two applications share the same sole inventor, David Sprogis. The office action alleges that the provisional application upon which priority is claimed is not described in the specification in such a way as to reasonably convey to one skilled in the art of cinema advertising that the inventor, at the time the application was filed, had possession

of the claimed invention (discussed *infra*). There are no specific features, however, identified in the office action as allegedly not being supported by the provisional application. Although the office action does include a rejection of certain claims under §112, ¶1 (on pages 7 - 9 thereof) , it is unclear whether the features later identified in connection with the §112, ¶1 rejection are the same features that allegedly defeat the claim for priority under §119. In any event, the support for certain of the claim elements that are identified in the connection with the §112, ¶1 is identified *infra* in both the utility application as well as the provisional application, and the remaining claim elements identified in connection with the §112, ¶1 rejection have been removed from the claims by the present amendment. Applicant submits, therefore, that the refusal to grant domestic priority to the applicant's provisional application Ser. No. 60/148,807 filed August 13, 1999 must be withdrawn.

Requirement for Information under 37 C.F.R. § 1.105

In the request for additional information under 37 C.F.R. §1.105, the office action specifically refers to Applicant's rigid comparison of the pending claims to the Digital Theatre Distribution System (DTDS) sold by National Cinema Network, Inc. (NCN) as well as a CineCast high definition MPEG decoder circuit board sold by Vela LP.

The entities National Cinema Network, Inc. and Vela LP are each unrelated to the Applicant and the assignee of the present application. See the accompanying affidavit of David H. Sprogis (Sprogis Affidavit), ¶¶ 16-17. Applicant became aware of the CineCast product and Vela LP in or about November 2000 (Sprogis Affidavit, ¶16.), and became aware of NCN's DTDS system in or about September 2000. Sprogis Affidavit, ¶17.

The Applicant conceived of the invention on or about December 5, 1998. Sprogis Affidavit, ¶4. The invention was constructively reduced to practice by August 13, 1999 when

the provisional application was filed, and was actually reduced to practice by March 17, 2000 when it became operational in Framingham, Massachusetts. Sprogis Affidavit, ¶14. The utility application was filed on July 28, 2000. The Applicant diligently continued to develop the system from December 5, 1998 through July 28, 2000. Sprogis Affidavit, ¶8.

In any event, and further responsive to the requirement under 37 C.F.R. §1.105 for additional information, applicant herewith submits the information that is identified on the enclosed document entitled Response to Request Under 37 C.F.R. §1.105.

With regard to each of the specific requests in paragraph 4 of the office action, Applicant states as follows:

The closest prior art of which Applicant was aware at the time of conception of the invention is disclosed in the background section of the present application. Sprogis Affidavit, ¶19.

In drafting the provisional patent application, Applicant relied on his technical background knowledge and experience. Sprogis Affidavit, ¶18. Applicant may have relied on one or more of the patent documents identified in the Response to Request Under 37 C.F.R. §1.105 filed herewith in reviewing the general format of patent documents. Sprogis Affidavit, ¶18. Applicant may have relied on background information regarding any of the products and companies identified in the provisional patent application, and may have further relied on one or more of the websites identified in the Response to Request Under 37 C.F.R. §1.105 filed herewith. Sprogis Affidavit, ¶18.

Objection to the specification under MPEP § 608.01

In the office action, the specification was objected to because it allegedly contains embedded hyperlinks and/or other forms of browser-executable code. The specification refers to www.php.net on page 20, line 23; and <http://www.cinecast.com> on page 22, line 15. The specification has been amended herein to remove these unnecessary references to Internet web site addresses.

Objection of claim 4

Claim 4 is objected to in the office action as not including a period. Claim 4 has been amended hereto to address this objection.

Rejection under 35 U.S.C. § 101

Claims 15 - 16 and 25 - 26 were rejected in the office action under 35 U.S.C. §101 because the subject matter claimed therein allegedly "does not recite a useful, concrete and tangible result" under In re Alappat, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994) and State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1093, 142 L.Ed.2d 704, 119 S.Ct. 851 (1999).

The Court of Appeals for the Federal Circuit held in State Street, *supra*, that:

the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a 'useful, concrete and tangible result'.

Id, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601.

As amended, independent claim 15 and dependent claim 16 are directed to a method of providing data representative of advertisement information to movie projection equipment in theatres, and include, *inter alia*, the steps of receiving data from a computer storage unit and selecting stored data from the computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly. At least these steps involve active interrelated functional steps relating to the manipulation of data, and are directed therefore, to statutory subject matter under §101.

As amended, independent claim 25 and dependent claim 26 are directed to a method of providing advertisement information to an audience, and include, *inter alia*, the steps of identifying a common interest characteristic that each of the members of a first audience have in common, and selecting a subset of advertisement information responsive to the common interest data. At least these steps also involve active interrelated functional steps relating to the manipulation of data, and are directed therefore, to statutory subject matter under §101.

The Federal Circuit also held in State Street, supra, that any step-by-step process involves an algorithm in the broadest sense and that to be patentable an algorithm must be applied in a useful way. See AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999) (reversing finding of patent invalidity under §101 for a telephone message recording method that involved generating and manipulating data).

The subject matter of each of claims 15 - 16 and 25 - 26 is plainly useful as it is embodied in a working system that is presently showing at well over one hundred theatre screens in Massachusetts, New York and New Jersey. Sprogis Affidavit, ¶¶ 14-15. Applicant submits, therefore, that each of claims 15 - 16 and 25 - 26 is directed toward statutory subject matter under 35 U.S.C. §101.

Rejections under 35 U.S.C. § 112, ¶1 and ¶2

Claims 1 - 26 were rejected under 35 U.S.C. §112, ¶1 because the specification allegedly does not disclose certain identified features. Claims 1 - 26 were also rejected under 35 U.S.C. §112, ¶2 as being allegedly indefinite with respect the same identified features.

Claim 1:

The following language from claim 1 is identified in the office action in connection with these §112 rejections.

a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies and a controller for selecting data responsive to said movie identification input unit

The pertinent portion of claim 1 has been amended herein to include the following:

a controller for selecting data responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly

The exemplary controller disclosed in the specification of the present application is the schedule daemon 86 shown in Figure 6 that runs on the servers 24 shown in Figure 2. The operation of the schedule daemon 86 is discussed, at least in part, at line 3 of page 37 through line 14 of page 38 in the present application. Exemplary operational software and hardware for the servers 24 are disclosed, at least in part, at line 15 of page 15 through line 20 of page 16 in the present application. Corresponding disclosure also appears, at least in part, in Figure 2 on page 7, paragraphs 2 - 4 on page 8, Figure 6 on page 13, and in paragraph 1 of page 21 through paragraph 1 on page 22 of the provisional application.

Claim 9:

The following language from claim 9 is identified in the office action in connection with the §112 rejections.

movie identification input unit for receiving first theatre scheduling information regarding a movie to be shown in a first theatre, said movie identification input unit being coupled to a processing unit coupled to a storage unit, and said processing unit being adapted to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to said first theatre scheduling information

The pertinent portion of claim 9 has been amended herein to include the following:

 said processing unit being adapted to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre

The exemplary processing unit disclosed in the specification of the present application is also the schedule daemon 86 shown in Figure 6 that runs on the servers 24 shown in Figure 2. Again, the operation of the schedule daemon 86 is discussed, at least in part, at line 3 of page 37 through line 14 of page 38 in the present application. Exemplary operational software and hardware for the servers 24 are disclosed, at least in part, at line 15 of page 15 through line 20 of page 16 in the present application. Corresponding disclosure also appears, at least in part, in Figure 2 on page 7, paragraphs 2 - 4 on page 8, Figure 6 on page 13, and in paragraph 1 of page 21 through paragraph 1 on page 22 of the provisional application.

Claim 15:

The following language from claim 15 is identified in the office action in connection with the §112 rejections.

generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies

The pertinent portion of claim 15 has been amended herein to include the following:

selecting certain stored data from the computer storage unit for transmission to a first digital projector assembly of said plurality of digital projector assemblies responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with said first digital projector assembly

The step of selecting is performed by the schedule daemon 86 shown in Figure 6 that runs on the servers 24 shown in Figure 2. Again, the operation of the schedule daemon 86 is discussed, at least in part, at line 3 of page 37 through line 14 of page 38 in the present application. Exemplary operational software and hardware for the servers 24 are disclosed, at least in part, at line 15 of page 15 through line 20 of page 16 in the present application. The exemplary computer storage unit disclosed in the specification is the database 70 shown in Figure 5, which includes the job and schedules database 100 and the job content volume 102 shown in Figure 6 and discussed, at least in part, at lines 14-18 of page 25. Corresponding disclosure also appears, at least in part, in Figure 2 on page 7, paragraphs 2 - 4 on page 8, Figure 5 on page 11, Figure 6 on page 13, paragraph 2 in page 14, and paragraph 1 of page 21 through paragraph 1 on page 22 of the provisional application.

Claim 17:

The following language from claim 17 is identified in the office action in connection with the §112 rejections.

common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information

The exemplary disclosure of the common interest identification means generally involves the use of the schedule daemon 86 shown in Figure 6, which runs on the servers 24, to access and review common interest data, for example, the tables CC_MOVIE, CC_MOVIE-RELEASE and CC_SHOWING as it becomes available on the system as discussed, in part, at line 15 of page 15 through line 20 of page 16, at lines 7-9 of page 23, at line 18 of page 32 through line 4 of page 33, at lines 3-13 of page 35, and at line 3 of page 37 through line 14 of page 38. Corresponding disclosure also appears, at least in part, in Figure 2 on page 7, paragraphs 2 - 4 on page 8, paragraph 5 on page 12, Figure 6 on page 13, paragraphs 5-6 on page 18, and in paragraph 1 on page 21 through paragraph 1 on page 22 of the provisional application.

Claim 25:

The following language from claim 25 is identified in the office action in connection with the §112 rejections.

generating common interest data representative of said common interest characteristics

The pertinent portion of claim 25 has been amended herein to include the following:

receiving common interest data representative of the common interest characteristic

The exemplary disclosure of the step of receiving common interest data also generally involves the use of the schedule daemon 86 shown in Figure 6, which runs on the servers 24, to access and review common interest data, for example, the tables CC_MOVIE, CC_MOVIE-RELEASE and CC_SHOWING as it becomes available on the system as discussed, in part, at line 15 of page 15 through line 20 of page 16, at lines 7-9 of page 23, at line 18 of page 32 through line 4 of page 33, at lines 3-13 of page 35, and at line 3 of page 37 through line 14 of page 38. Corresponding disclosure also appears, at least in part, in Figure 2 on page 7, paragraphs 2 - 4 on page 8, paragraph 5 on page 12, Figure 6 on page 13, paragraphs 5-6 on page 18, and in paragraph 1 on page 21 through paragraph 1 on page 22 of the provisional application.

Rejection under 35 U.S.C. §112, ¶6

Claims 17 - 23 were further rejected under 35 U.S.C. §112, ¶6 as allegedly "not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation." Office action, p.12. It is alleged in the office action that the specification does not provide a clear limit of patentability for the storage means, common interest identification means, selection means, and display means of claims 17 - 23.

Paragraph 6 of Section 112 sets for the limits on how broadly such claims may be construed as follows:

An element in a claim for a combination may be expressed as a means or a step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. §112, ¶6.

During examination of a claim by the U.S. Patent and Trademark Office, the claim must be interpreted in accordance with ¶6 of §112. In re Donaldson Co., Inc., 16 F.3d 1189, 1194, 29 U.S.P.Q.2d 1845, 1849 (Fed. Cir. 1994) *en banc*.

The means plus function elements of claims 17 - 23, therefore, must be interpreted to cover the structure disclosed in the specification for performing the specified function, and equivalents thereof. 35 U.S.C. §112, ¶6. The disclosure structure for the recited storage means, common interest identification means, selection means and display means are as follows:

storage means for receiving and storing advertisement information regarding a plurality of advertisements

An exemplary disclosed structure for this element involves the database 70 shown in Figure 5, which is part of the servers 24 shown in Figure 2, and discussed, at least in part, at line 15 of page 15 through line 20 of page 16, and lines 21-22 of page 22. In particular, the database 70 includes the job and schedules database 100 and job content volume 102 shown in Figure 6 and discussed, at least in part at lines 14-18 of page 25.

common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information

As discussed above, an exemplary disclosed structure for this element generally involves the use of the schedule daemon 86 shown in Figure 6, which runs on the servers 24, to access and review common interest data, for example, the tables CC_MOVIE, CC_MOVIE-RELEASE and CC_SHOWING as it becomes available on the system as discussed, in part, at line 15 of page 15 through line 20 of page 16, at lines 7-9 of page 23, at line 18 of page 32 through line 4 of page 33, at lines 3-13 of page 35, and at line 3 of page 37 through line 14 of page 38.

selection means for selecting a subset of the advertisement responsive to the common interest information

An exemplary disclosed structure for this element is the schedule daemon 86 shown in Figure 6 that runs on the servers 24 shown in Figure 2. The operation of the schedule daemon 86 is discussed, at least in part, at line 3 of page 37 through line 14 of page 38 in the present application. Exemplary operational software and hardware for the servers 24 are disclosed, at least in part, at line 15 of page 15 through line 20 of page 16 in the present application.

display means for permitting the selected subset of the advertisement information to be displayed to the first audience

An exemplary disclosed structure for this element is a client assembly 30, which includes a digital projector 34, shown in Figures 2 and 3 and discussed, at least in part, at line 21 of page 16 through line 14 of page 17. Other exemplary structure is also disclosed with reference to the client assemblies 44 and projectors 52 shown in Figure 4.

The above claim language, therefore, is clear, concise and fully supported by the present application. See S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 59 U.S.P.Q.2d 1745 (Fed. Cir. 2001) (reversing finding of patent invalidity under §112, ¶6 for patentee's alleged failure to disclose sufficient supporting structure in the specification for a data receiving and converting means).

Rejection under 35 U.S.C. §102

Claims 1 - 26 were rejected under 35 U.S.C. §102(a) over WO 00/00917 (to Hughes et al.), or "Partnership formed" from Screen Digest, or the NCN trademark filing of DTDS on December 30, 1999.

NCN trademark filing of DTDS

The NCN trademark filing of DTDS (Ser. No. 75/884194) indicates a filing date of December 30, 1999, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4, 8 and 14), it is respectively submitted that this reference does not constitute prior art to the present application.

Screen Digest "Partnership formed"

The Screen Digest document is dated July 1999, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4, 8 and 14), it is respectively submitted that this document does not constitute prior art to the present application.

WO 00/00917 (to Hughes et al.)

The Hughes et al. reference was published on January 6, 2000, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4, 8 and 14), it is respectively submitted that this reference does not constitute prior art to the present application under 35 U.S.C. §102(a). Moreover, the Hughes et al. reference does not constitute

prior art under 35 U.S.C. §102(e). In any event, the Hughes et al. reference discloses a method and apparatus for controlling the distribution of advertisements to elevators. The Hughes et al. reference does not disclose each of the elements of any of independent claims 1, 9, 15, 17 or 25.

In particular, the Hughes et al. reference includes no disclosure of, among other elements, a controller for selecting certain stored data for transmission to a first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 1.

The Hughes et al. reference includes no disclosure of, among other elements, a processing unit that is adapted to provide a first portion of data representative of advertisement information to a first digital projector responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre as claimed in claim 9.

The Hughes et al. reference includes no disclosure of, among other elements, a step of selecting certain stored data from a computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 15.

The Hughes et al. reference includes no disclosure of, among other elements, a selection means for selecting a subset of advertisement information responsive to common interest information as claimed in claim 17.

The Hughes et al. reference includes no disclosure of, among other elements, a step of selecting a subset of advertisement information responsive to common interest data as claimed in claim 25.

The Hughes et al. reference, therefore, does not disclose each of the elements of any of independent claims 1, 9, 15, 17 or 25, and rejection of claims 1-26 under §102(a) should be withdrawn.

Claims 1 - 26 were rejected under 35 U.S.C. §102(b) over US 5,227,874 (to von Kohorn), or "Movies get a chunk" from Miami Herald, or "Proxima and NCN" from Business Wire, or US 5,568,181 (to Greenwood et al.), or US 5,761,601 (to Nemirofsky et al.), or US 5,801,754 (to Ruybal et al.), or WO 99/36341 (to DiFranza et al.), or WO 99/08216 (to Stern).

"Proxima and NCN" from Business Wire

The Business Wire reference is dated June 1999, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4, 8 and 14), it is respectively submitted that this reference does not constitute prior art to the present application.

U.S. Patent No. 5,227,874 (to von Kohorn)

The von Kohorn reference discloses a method for evaluating broadcast commercials that are intended to promote purchases by shoppers. The method involves the use of interactive data acquisition and/or coupon dispensing units at stations that include television, radio or printed advertisements in a shopping environment such as a retail store. The von Kohorn reference includes no disclosure of, among other elements, selecting certain advertisements responsive to movie show schedule information

Miami Herald "Movies get a chunk"

The Miami Herald reference discloses a news article relating to a company called Screenvision Cinema Network of New York. The advertising service discussed in the Miami Herald article appears to be duplicative of the rolling stock prior art discussed in the background of the present application at lines 15-16 of page 2. In any event, the Miami Herald reference does not disclose each of the elements of any of independent claims 1, 9, 15, 17 or 25.

U.S. Patent No. 5,568,181 (to Greenwood et al.)

The Greenwood et al. reference discloses a video distribution management system that utilizes a shared video library and a wide area network to deliver video files to local caches on local area networks serving a subset of local viewing stations. The Greenwood et al. reference includes no disclosure of the processing or management of advertisements *per se*, and includes no disclosure of selecting certain advertisements responsive to movie show schedule information.

U.S. Patent No. 5,761,601 (to Nemirofsky et al.)

The Nemirofsky et al. reference discloses the distribution of advertisements to businesses, such as retail stores, that are dispersed over a wide geographical area. Although the reference discloses that video programs may be customized for particular target audiences or markets, it discloses only that pre-defined market specific segments 22 may be directed to certain geographic areas in place of a network-wide program. The reference does not disclose the selection of content responsive to information regarding the specific viewing audience. In fact, the viewing audience identified in the reference is shoppers at retail stores such as supermarkets, which may have little or nothing in common with one another other than their geographic

location. The insertion control unit 56 of the reference is not responsive to information regarding the audience, but rather is responsive to a command to switch between local or national programming.

U.S. Patent No. 5,801,754 (to Ruybal et al.)

The Ruybal et al. reference discloses an interactive theatre network system that is disclosed to link together a plurality of motion picture theatre auditoriums so that live, interactive events may be conducted with theatre audiences throughout the theatre network. The reference also states that the system has the ability to provide audience responses at any or all of the particular theaters in the network. The reference does not disclose the distribution of advertisements or the distribution of stored data responsive to information regarding the audience in each theatre.

WO 99/36341 (to DiFranza et al.)

The DiFranza et al. reference discloses a system for displaying video information to passengers of an elevator in accordance with a play list defining a sequence of messages. Although the video images may include digital advertising and the system collects or determines the geographical location, the elevator traffic patterns of the building, and the nature of the business of the building occupants, there is no disclosure of the selection of certain advertisement data responsive to movie show schedule information that is dynamic with regard to each location.

WO 99/08216 (to Stern)

The Stern reference discloses a method and apparatus for distributing advertisements to sites that are disclosed to be located in a store such as retail store. Although the system is disclosed to provide information to the store sites corresponding to products that are proximate thereto, the product information is gathered from customer queries that are placed that store sites such as kiosks. The system does not disclose the selection of certain advertisement data responsive to movie show schedule information.

None of these references (von Kohorn reference, the Miami Herald reference, the Greenwood et al. reference, the Nemirofsky et al. reference, the Ruybal et al. reference, the DiFranza et al. reference, or the Stern reference) discloses each of the elements of any of independent claims 1, 9, 15, 17 or 25.

None of these references includes a disclosure of, among other elements, a processing unit that is adapted to provide a first portion of data representative of advertisement information to a first digital projector responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre as claimed in claim 9.

None of these references includes a disclosure of, among other elements, a step of selecting certain stored data from a computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 15.

None of these references includes a disclosure of, among other elements, a selection means for selecting a subset of advertisement information responsive to common interest information as claimed in claim 17.

None of these references includes a disclosure of, among other elements, a step of selecting a subset of advertisement information responsive to common interest data as claimed in claim 25.

None of these references, therefore, includes a disclosure of each of the elements of any of independent claims 1, 9, 15, 17 or 25, and rejection of claims 1-26 under §102(b) should be withdrawn.

Claims 1 - 26 were rejected under 35 U.S.C. §102(e) over US 5,983,069 (to Cho et al.), or US 6,009,465 (to Decker et al.), or US 6,038,367 (to Rider et al.), or non-patent literature background information from NCNInc.com.

Non-patent literature background information from NCNInc.com

The NCNInc.com reference is dated September 25, 2002, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4, 8 and 14), it is respectively submitted that this reference does not constitute prior art to the present application. Moreover, to the extent that any of the text contained therein is alleged to refer to subject matter that may comprise prior art, such subject matter is believed to be duplicative of the prior art referenced in the background section of the present application at line 9 of page 2 through line 2 of page 3.

U.S. Patent No. 5,983,069 (to Cho et al.)

The Cho et al. reference discloses a video distribution system for distributing advertisements to sites, such as retail stores, that are dispersed over a wide geographic area.

Although the system appears to permit users at distribution centers to customize a video program for a particular target audience or market, there is no disclosure of the selection of certain advertisement data responsive to movie show schedule information.

U.S. Patent No. 6,009,465 (to Decker et al.)

The Decker et al. reference discloses a remote video delivery system that transmits video and text from a hotel office to hotel rooms. Although the users in the hotel rooms may select certain programs, there is no disclosure of the selection of certain advertisement data responsive to movie show schedule information.

U.S. Patent No. 6,038,367 (to Rider et al.)

The Rider et al. reference discloses a system and facility for video games with a large number of user stations and a single screen upon which the video games are displayed that is visible from each of the user stations. The reference discloses neither the transmission or display of advertisements, nor the selection of certain advertisement data responsive to movie show schedule information.

In particular, none of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference includes a disclosure of, among other elements, a controller for selecting certain stored data for transmission to a first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 1.

None of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference includes a disclosure of, among other elements, a processing unit that is adapted to provide a first

portion of data representative of advertisement information to a first digital projector responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre as claimed in claim 9.

None of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference includes a disclosure of, among other elements, a step of selecting certain stored data from a computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 15.

None of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference includes a disclosure of, among other elements, a selection means for selecting a subset of advertisement information responsive to common interest information as claimed in claim 17.

None of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference includes a disclosure of, among other elements, a step of selecting a subset of advertisement information responsive to common interest data as claimed in claim 25.

None of the Cho et al. reference, the Decker et al. reference, nor the Rider et al. reference, therefore, anticipates any of independent claims 1, 9, 15, 17 or 25, and rejection of claims 1-26 under §102(e) should be withdrawn.

Claims 1 - 26 were rejected under 35 U.S.C. §102(b) based on alleged public use or on sale activity relating to the CineCast HD information posted on a website.

The alleged public use or on sale activity relating to the CineCast HD information appears to relate to the Vela LP document that is cited in the PTO Form 892 and describes the CineCast HD product, but does not appear to be printed from a website. The document, which is not specifically dated other than a copyright notice with a data range of 1998-2001, appears to

disclose a high definition MPEG decoder circuit board. The entity Vela LP is not related to the applicant and has no information regarding the decoder circuit boards advertised therein other than that which is disclosed in the document. There is no disclosure in this Vela LP document of each of the elements of any of claims 1, 9, 15, 17 or 25.

In particular, the Vela LP document includes no disclosure of, among other elements, a controller for selecting certain stored data for transmission to a first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 1.

The Vela LP document includes no disclosure of, among other elements, a processing unit that is adapted to provide a first portion of data representative of advertisement information to a first digital projector responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre as claimed in claim 9.

The Vela LP document includes no disclosure of, among other elements, a step of selecting certain stored data from a computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 15.

The Vela LP document includes no disclosure of, among other elements, a selection means for selecting a subset of advertisement information responsive to common interest information as claimed in claim 17.

The Vela LP document includes no disclosure of, among other elements, a step of selecting a subset of advertisement information responsive to common interest data as claimed in claim 25.

The rejection of claims 1-26 based on alleged public use or on-sale activity, therefore, must be withdrawn, and rejection of claims 1-26 under §102(b) based on on-sale or public use activity should be withdrawn.

Rejection under 35 U.S.C. §103

Claims 1 - 26 were rejected under 35 U.S.C. §103(a) over a Cyberstar press release dated November 9, 1998 in view of US 5,133,079 to (Ballantyne et al.) or in view of US 6,424,998 (to Hunter et al.).

Cyberstar press release dated November 9, 1998

The Cyberstar reference discloses an announcement that as of November 9, 1998, National Cinema Network had selected Cyberstar L.P. to "implement new technology that will deliver in-theatre media to its nationwide cinema network". Cyberstar reference, page 1. Although the reference discloses that advertisements data will be delivered to theatres, there is no disclosure of the selection of certain advertisement data responsive to movie show schedule information.

U.S. Patent No. 5,133,079 to (Ballantyne et al.)

The Ballantyne et al. reference discloses a method an apparatus for distributing movies for viewing on a customer's television set. Although the customers may select certain programs, there is no disclosure of the selection of certain advertisement data responsive to movie show schedule information.

U.S. Patent No. 6,424,998 (to Hunter et al.)

The Hunter et al. reference issued on July 23, 2002 and claims an original priority filing date of April 28, 1999, which is after Applicant's date of conception. In view of Applicant's earlier date of conception and diligence in constructively and then actually reducing the invention to practice (Sprogis Affidavit, ¶¶ 4,8 and 14), it is respectfully submitted that this reference does not constitute prior art to the present application.

None of the references discloses, teaches or suggests each of the elements of the independent claims. In particular, neither the Cyberstar reference nor the Ballantyne et al. reference, nor any combination thereof, includes a disclosure of, among other elements, a controller for selecting certain stored data for transmission to a first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 1.

Neither the Cyberstar reference nor the Ballantyne et al. reference, nor any combination thereof includes a disclosure, teaching or suggestion of, among other elements, a processing unit that is adapted to provide a first portion of data representative of advertisement information to a first digital projector responsive to first theatre scheduling information regarding a movie that is to be shown in the first theatre as claimed in claim 9.

Neither the Cyberstar reference nor the Ballantyne et al. reference, nor any combination thereof includes a disclosure, teaching or suggestion of, among other elements, a step of selecting certain stored data from a computer storage unit for transmission to a first digital projector assembly responsive to movie identification information regarding a movie that is to be shown in a theatre environment associated with the first digital projector assembly as claimed in claim 15.

Neither the Cyberstar reference nor the Ballantyne et al. reference, nor any combination thereof includes a disclosure, teaching or suggestion of, among other elements, a selection means for selecting a subset of advertisement information responsive to common interest information as claimed in claim 17.

Neither the Cyberstar reference nor the Ballantyne et al. reference, nor any combination thereof includes a disclosure, teaching or suggestion of, among other elements, a step of selecting a subset of advertisement information responsive to common interest data as claimed in claim 25.

None of claims 1, 9, 15, 17 or 25, therefore, is disclosed, taught or suggested by any of the Cyberstar reference, the Ballantyne et al. reference, or any combination thereof. The rejection of claims 1-26 under §103(a) should be withdrawn.

Applicant respectfully urges that each of claims 1 - 26 is in condition for allowance. Favorable action consistent with the above is respectfully requested.

Respectfully submitted,



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